

U.S. Serial No.: 10/608,899
Filed: June 27, 2003
Group Art Unit: 3738
Examiner: Javier G. Blanco
Atty. Docket No.: 22956-218 (MTT-5010)

REMARKS

The pending Office Action addresses claims 1-19. Claims 10 and 18-19 are withdrawn from consideration, and claims 1-9 and 11-17 stand rejected. Reconsideration is respectfully requested in view of the following remarks.

Amendments to the Claims

Applicants amend claims 1, 2, 5, and 17 to correct typographical errors. Claim 1 is also amended to clarify that each sidewall of the radially expandable sheath is at least partially separated by a longitudinally oriented slot extending from a proximal end along a substantial length of each sidewall and terminating at a position "just" proximal to the distal end. Support for this amendment can be found throughout the specification, for example at paragraph 22, lines 11-12 of the published application. No new matter is added.

Applicants cancel withdrawn claims 10 and 18-19. Applicants reserve the right to pursue these claims in a divisional application.

Claims 1-9 and 11-17 are now pending.

Election/Restriction Requirement

Applicants confirm the election of the Group I claims (claims 1-9 and 11-17), and elect these claims without traverse. Claims 10 and 18-19 are withdrawn from consideration, and are now cancelled.

Claim Objections

The Examiner objects to claims 1, 2, 5, and 17 due to several informalities. As indicated above, claims 1, 2, 5, and 17 are amended as suggested by the Examiner, thereby obviating the basis for these objections.

Rejection Pursuant to 35 U.S.C. §102

The Examiner rejects claims 1, 4-9, 11, 12, and 14-17 pursuant to 35 U.S.C. §102(b) as being anticipated by U.S. Publication No. 2002/0072797 of Hays, which is now U.S. Patent No. 6,554,862. Applicants respectfully disagree.

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Independent claims 1 and 11 recite a graft fixation device (claim 1) or a kit that includes a graft fixation device (claim 11) having a bioabsorbable radially expandable sheath with at least two sidewalls extending proximally therefrom. Each sidewall is at least partially separated by a longitudinally oriented slot that extends from a proximal end along a substantial length of each sidewall and terminates at a position just proximal to the distal end. Hays does not teach or even suggest slots that separate the sidewalls and that extend from a proximal end and terminate just proximal to a distal end.

Hays discloses a graft ligament anchor with a sheath having four longitudinal sidewall segments with structurally weakened fracture regions extending longitudinally between the sidewalls. The weakened fracture regions are not slots that separate the sidewalls, as required by independent claims 1 and 11. Rather, they are "formed by thinning the material of sidewall 401 longitudinally in the region of desired fracture, and in one embodiment, may be a longitudinal groove cut into sidewall 401." Col. 11, lines 34-37 of U.S. Patent No. 6,544,862 of Hays. Since the sidewalls remain connected along a substantial length thereof, the thinned material or groove formed between the sidewalls cannot be considered to be a slot that separates the sidewalls, as required by independent claims 1 and 11. The only portion of the sheath disclosed in Hays that can be considered to be a slot is the proximal and distal cut out areas 406, 452 shown in Figure 24. These cut-out areas do not, however, extend from a proximal end and terminate just proximal to the distal end, as required by claims 1 and 11.

We further note that it would not have been obvious to include slots that extend from a proximal end and terminate just proximal to the distal end on the device of Hays, as nothing in Hays teaches or even suggests the use of such slots. Rather, Hays is directed solely towards structurally weakened fracture regions that are formed between the sidewalls. The law of obviousness requires that there be a suggestion or a motivation in Hays to modify it to include slots. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Hays provides no such motivation. Rather, Hays relies on the weakened fracture regions to attach the sidewalls to one another and provide strength to the device during expansion. If a sidewall is to fail during expansion due to lack of strength, the weakened fracture regions serve as a back up, and can fracture to prevent the overall loss of functionality of the device. Col. 11, lines 26-47 of U.S. Patent No. 6,554,862 of Hays. This appears to teach away from the use of slots, as one would expect slots formed between the sidewalls to weaken the device weaker. Applicants, however, have discovered that that the use of slots are actually an improvement over the use of such weakened fracture regions.

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Accordingly, claims 1 and 11, as well as claims 4-9, 11, 12, and 14-17 which depend therefrom, distinguish over Hays and represent allowable subject matter.

Rejections Pursuant to 35 U.S.C. §103

The Examiner rejects dependent claims 2 and 13 pursuant to 35 U.S.C. §103(a) as being obvious over Hays. The Examiner also rejects dependent claim 3 pursuant to 35 U.S.C. §103(a) as being obvious over Hays in view of U.S. Patent No. 6,099,530 of Simonian. As noted above, Hays does not teach or even suggest a slot that extends from a proximal end and terminates just proximal to the distal end. Simonian does not remedy the deficiencies of Hays, as Simonian likewise does not teach or even suggest such a slot. Accordingly, claims 2, 3, and 13 distinguish over Hays and Simonian and represent allowable subject matter.

Conclusion

Applicants submit that all pending claims are now in condition for allowance, and allowance thereof is respectfully requested. The Examiner is encouraged to telephone the undersigned attorney for Applicants if such communication is deemed to expedite prosecution of this application.

Respectfully submitted,

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